



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/991,894

11/13/2001

Scott Lascelles

132538-1016

4186

32914 7590 01/14/2009
GARDERE WYNNE SEWELL LLP
INTELLECTUAL PROPERTY SECTION
3000 THANKSGIVING TOWER
1601 ELM ST
DALLAS, TX 75201-4761

EXAMINER

MALHOTRA, SANJEEV

ART UNIT

PAPER NUMBER

3694

MAIL DATE

DELIVERY MODE

01/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/991,894	Applicant(s) LASCELLES ET AL.	
	Examiner SANJEEV MALHOTRA	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11-28-2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This Office Action is a final rejection in response to the remarks/ arguments/ amendments to claims filed on November 21, 2008 for the original application filed on November 13, 2001 and titled: "On-line Balance Transfers".

Examiner notes that Claims 1, 5--8, 11, 13, 14 and 16 have been currently amended per claim amendments submitted on November 21, 2008, which include the three independent Claims 1, 14 and 16. Additionally, in the "Claim Listing" starting at "Page 2 of 14" there appears to be addition of new claims 18--24, but the REMARKS section filed on November 21st, 2008 clearly states on top of "Page 8 of 14" --- *"Claims 1-16 are pending in the application. Claim 17 has been cancelled without prejudice."* Examiner seeks clarification if any claims are being added, since Neither any mention has been made about the addition of new claims in Applicant's remarks of November 21, 2008 Nor is there any detail provided about the support in the specification for the additional new claims 18-24 in the Applicant's remarks, and hence, no entry of "new claims" 18-24 is being done at this time pending clarification by the Applicant. Hence, only Claims 1-16 are now considered with cancellation of Claim 17 and pending further clarification is provided for addition of new Claims 18-24 (as requested above).

Claim Objections

2. Claims 1-16 are objected to because of the following informalities:

The status of each of the previous claim objections is given hereunder. The previous Office Action stated --- “As recited currently, the amended claims are missing the following (underlined and italicized words show the changes):”

“I/We claim:” --- Pending still, no response given by the Applicant in its November 21, 2008 remarks. *“Appropriate correction is required.”* To clarify, Examiner notes the ‘amendments to the claims’ submitted either on 12th May, 2008 and again on 21st November, 2008 were missing a phrase at the beginning of claims, such as “I Claim:” or “We Claim:” or “What is claimed is:” --- that was also missing in the original listing of the claims dated November 13th, 2001.

“Claim 1: (Currently amended) (Not ‘Amended’ as currently recited)” --- Withdrawn based on amendments to the claims and/or clarifications of November 21, 2008.

“Claim 12: (Currently amended) (Not ‘Original’ as currently recited)” --- Withdrawn based on amendments to the claims and/or clarifications of November 21, 2008.

“Claim 1: Line 15 currently recites two phrases consecutively, “processing the balance transfer” and “the request”, and some word(s) appear to be missing between these two phrases.” --- Withdrawn based on amendments to the claims and/or clarifications of November 21, 2008.

3. New Claim Objections ---

Claims 1-16 are objected to because of the following informalities after the Applicant’s response dated November 21, 2008 is entered ---

- Independent method Claim 1, line 3 recites the limitation “with the account holder comprising:” at the end of its preamble ending with a verb ending in “ing”, and each of the new step limitation starts with another verb ending in “ing”, such as “receiving”, “obtaining”, “determining” and “processing”, which is incorrect English; and the Examiner suggests that a connector, “of”, be added to the limitation at the end of preamble to be read as --- “with the account holder comprising of:”, and such a minor change will not require having to alter the remaining recitations of the claim.
- Claim 6, line 5 recites the limitation “institution with is affiliated with” and the Examiner believes that the first “with”, shown underlined, is superfluous and incorrect English, and hence, it is suggested that the first “with” be deleted so that this limitation will be read as --- “institution is affiliated with”.
- Claim 9, lines 2-3 recite the limitation “further comprising:” at the end of its preamble ending with a verb ending in “ing”, and each of the new step limitation starts with another verb ending in “ing”, such as “receiving”, “obtaining”, which is incorrect English; and the Examiner suggests that a connector, “of”, be added to the limitation at the end of preamble to be read as --- “further comprising of:”, and such a minor change will not require having to alter the remaining recitations of the claim.
- Claim 11, lines 2-3 recite the limitation “further comprising” at the end of its preamble ending with a verb ending in “ing”, and the new step limitation starts with another verb ending in “ing”, such as “displaying”, which is incorrect English; and the Examiner suggests that a connector, “of”, be added to the limitation at the end of preamble to be

read as --- “further comprising of displaying”, and such a minor change will not require having to alter the remaining recitations of the claim.

- Claim 11, line 5 recites the limitation “with the financial institution” and the Examiner believes it is missing the word “second” and should be correctly recited as --- “with the second financial institution”, because the cancelled limitation in the same claim recited --
- “with which the second credit account is held”.
- Claim 12, lines 2-3 recite the limitation “further comprising:” at the end of its preamble ending with a verb ending in “ing”, and each of the new step limitation starts with another verb ending in “ing”, such as “providing”, “populating”, which is incorrect English; and the Examiner suggests that a connector, “of”, be added to the limitation at the end of preamble to be read as --- “further comprising of”, and such a minor change will not require having to alter the remaining recitations of the claim.

Appropriate corrections are required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Withdrawn.
- b. Withdrawn.
- c. Withdrawn.
- d. Withdrawn.
- e. Independent Claim 1 recites the limitation “the received balance transfer request” in lines 17-18 that is indefinite and/or unclear. Because there is insufficient antecedent basis for this limitation in the claim. Additionally, Examiner notes that “the balance transfer request” has been recited in line 16 that takes proper antecedent basis from line 5 of this claim, and so Examiner is unclear as to which “balance transfer request” limitation is being referenced in lines 17-18 now.
- f. Withdrawn.
- g. Withdrawn.
- h. Withdrawn.
- i. Withdrawn.
- j. Withdrawn.
- k. Withdrawn.
- l. Withdrawn.
- m. Withdrawn.
- n. Claim 5 recites the limitation “the same financial institution” in line 5 that is indefinite. Because there is insufficient antecedent basis for this limitation in the claim. Examiner notes that the limitation “financial institution” is recited in many lines of Claim

l as noted above, and Examiner seeks clarification as to which “financial institution” is being referenced in line 5 now.

o. Withdrawn.

p. Withdrawn.

q. Withdrawn.

r. Withdrawn.

s. Withdrawn.

t. Withdrawn.

u. Withdrawn.

v. Withdrawn.

w. Withdrawn.

x. Withdrawn.

y. Withdrawn.

z. Withdrawn.

aa. Claim 8 recites the limitation “comprises second the financial institution” in line 3 that is indefinite and/or unclear. Because there is insufficient antecedent basis for the limitation “the financial institution” in this claim, and Examiner notes that the limitation “financial institution” is recited in many lines of Claim 1 as noted above, and Examiner seeks clarification as to which “financial institution” is being referenced in line 3 now. Additionally, Examiner seeks clarification about the limitation “comprises second the financial institution” recites in line 3 that is incorrect English, which requires correction.

bb. Withdrawn.

cc. Withdrawn.

dd. Claim 11 recites the limitation “the financial institution” in line 5 that is indefinite. Because there is insufficient antecedent basis for this limitation in the claim. Examiner notes that the limitation “financial institution” is recited in many lines of Claim 1 as noted above, and Examiner seeks clarification as to which “financial institution” is being referenced in line 5 now. However, as suggested by the Examiner in the Claims Objection section, should the Applicant agree to change this limitation to be read as --- “the second financial institution”, then this rejection can be withdrawn.

ee. Claim 12 recites the limitation “the display” in line 3 that is indefinite. Because there is insufficient antecedent basis for this limitation in the claim. Examiner notes that the limitation “a balance transfer request display” is recited in line 3 of Claim 12.

ff. Claim 13 recites the limitation “the display” in line 4 that is indefinite. Because there is insufficient antecedent basis for this limitation in the claim. Examiner notes that the limitation “a balance transfer request display” is recited in line 4 of Claim 13.

gg. Withdrawn.

hh. Withdrawn.

ii. Independent Claim 14 recites the limitation “the financial institution” in line 7 that is indefinite and/or unclear. Because there is insufficient antecedent basis for this limitation in the claim. Additionally, Examiner seeks clarification as to which “financial institution” is meant in this recitation --- “the first financial institution” or “the second financial institution”?

jj. Independent Claim 14 recites the limitation “the balance request” in line 9 that is indefinite and/or unclear. Because there is insufficient antecedent basis for this limitation in the claim. Additionally, Examiner seeks clarification if it is the same as the recitation of “the online balance transfer request” in line 13 of this Claim?

kk. Withdrawn.

ll. Withdrawn.

mm. Independent Claim 14 recites the limitation “the received balance transfer request” in line 16 that is indefinite. Because there is insufficient antecedent basis for this limitation in the claim. Additionally, Examiner seeks clarification how it is different from the recitation of “the online balance transfer request” in line 13 of this Claim?

nn. Withdrawn.

oo. Withdrawn.

pp. Independent Claim 16 recites the limitation “the financial institution” in line 6 that is indefinite and/or unclear. Because there is insufficient antecedent basis for this limitation in the claim. Additionally, Examiner seeks clarification as to which “financial institution” is being referenced herein in line 6 of the independent Claim 16?

qq. Independent Claim 16 recites the limitation “the balance request” in line 7 that is indefinite and/or unclear. Because there is insufficient antecedent basis for this limitation in the claim. Additionally, Examiner seeks clarification as to which “balance request” is being referenced herein in line 7 of the independent Claim 16?

rr. Withdrawn.

ss. Withdrawn.

tt. Independent Claim 16 recites the limitation “the online balance transfer request” in line 11 that is indefinite and/or unclear. Because there is insufficient antecedent basis for this limitation in the claim. Additionally, Examiner seeks clarification as to which “balance transfer request” is being referenced herein in line 11 of independent Claim 16?

uu. Independent Claim 16 recites the limitation “the online balance transfer request” in line 12 that is indefinite and/or unclear. Because there is insufficient antecedent basis for this limitation in the claim. Additionally, Examiner seeks clarification as to which “balance transfer request” is being referenced herein in line 12 of independent Claim 16?
Appropriate corrections are required.

5. New Claim Rejections ---

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Independent Claim 1, line 12 recites the limitation “the account data” that is indefinite and/or unclear. Because there is insufficient antecedent basis for this limitation in the claim. Additionally, Examiner seeks clarification as to which “account data” is being referenced herein in line 12 of the independent Claim 1, is it “the first credit account data” or “the second credit account data”?

(ii) Claim 2, line 3 recites the limitation “the account data” that is indefinite and/or unclear. Because there is insufficient antecedent basis for this limitation in the claim. Additionally, Examiner seeks clarification as to which “account data” is being referenced

herein in line 3 of Claim 2, is it “the first credit account data” or “the second credit account data”?

(iii) Claim 10, line 3 recites the limitation “said account data” that is indefinite and/or unclear. Because there is insufficient antecedent basis for this limitation in the claim. Additionally, Examiner seeks clarification as to which “account data” is being referenced herein in line 3 of Claim 10, is it “the first credit account data” or “the second credit account data”?

(iv) Claim 11, line 3 recites the limitation “said account data” that is indefinite and/or unclear. Because there is insufficient antecedent basis for this limitation in the claim. Additionally, Examiner seeks clarification as to which “account data” is being referenced herein in line 3 of Claim 11, is it “the first credit account data” or “the second credit account data”?

(v) Claim 12, line 6 recites the limitation “said account data” that is indefinite and/or unclear. Because there is insufficient antecedent basis for this limitation in the claim. Additionally, Examiner seeks clarification as to which “account data” is being referenced herein in line 6 of Claim 12, is it “the first credit account data” or “the second credit account data”?

(vi) Claim 13, line 9 recites the limitation “said account data” that is indefinite and/or unclear. Because there is insufficient antecedent basis for this limitation in the claim. Additionally, Examiner seeks clarification as to which “account data” is being referenced herein in line 3 of Claim 10, is it “the first credit account data” or “the second credit account data”?

Appropriate corrections are required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16, as understood by the Examiner, are rejected under 35 USC 103(a) as being unpatentable over Patent No. US 5,590,038 issued to Pitroda, Satyan G. filed on June 20, 1994 and titled: "Universal Electronic Transaction Card including Receipt Storage and System and Methods of Conducting Electronic Transactions" (hereinafter "Pitroda") in view of US Patent No. 6,267,292 issued to Walker et al. filed on July 22, 1999 claiming priority from June 13, 1997 and titled: "Method and Apparatus for Funds and Credit Line Transfers" (hereinafter "Walker").

With respect to Claim 1, Pitroda teaches "A computer implemented method for online transfer of a balance from a first credit account associated with an account holder to a second credit account associated with the account holder comprising:" (see at least Abstract and Summary)

"receiving at a computer a balance transfer request for transferring a balance from the first credit account to the second credit account;" (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

"obtaining account data associated with the first credit account, said account data comprising at least an identifier for a first financial institution with which the first credit account is held;" (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

"determining using with a business logic server, using the account data, whether the first

Art Unit: 3694

financial institution with which the first credit account is held is related to a second financial institution with which the second credit account is held;" (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

"processing the balance transfer request if it meets all of at least one eligibility requirement for transferring the balance, and otherwise not processing the received balance transfer request; the at least one eligibility requirement comprising a requirement that the first credit account as being not eligible for a balance transfer to said second credit account if it is determined that the first credit account and the second credit card account not be held by related financial institutions." (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see at least Walker Abstract and Summary, and C 2, ~L 20-30)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

Examiner notes that Walker explicitly teaches about balance transfer and states that "it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer, which draws the old account balance onto the new credit card account."

With respect to Claim 2, Pitroda teaches "wherein the account data is obtained in real time." (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

With respect to Claim 3, Pitroda teaches "wherein the account data is obtained from a source other than the account holder." (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

With respect to Claim 4, Pitroda teaches "wherein the source other than the account holder is a credit reporting bureau." (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Art Unit: 3694

With respect to Claim 5, Pitroda teaches “wherein the first and second financial institutions are the same financial institution.” (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see at least Walker Abstract and Summary, and C 2, ~L 20-30)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

Examiner notes that Walker explicitly teaches about balance transfer and states that “it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer, which draws the old account balance onto the new credit card account.”

With respect to Claim 6, Pitroda teaches “wherein the first financial institution is considered related to the second financial institution if the first financial institution with is affiliated with the second financial institution.” (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see at least Walker Abstract and Summary, and C 2, ~L 20-30)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

Examiner notes that Walker explicitly teaches about balance transfer and states that “it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer, which draws the old account balance onto the new credit card account.”

Art Unit: 3694

With respect to Claim 7, Pitroda teaches “wherein determining whether the first financial institution is related to the second financial institution comprises comparing the first financial institution with a list of ineligible financial institutions.” (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see at least Walker Abstract and Summary, and C 2, ~L 20-30)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

Examiner notes that Walker explicitly teaches about balance transfer and states that “it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer, which draws the old account balance onto the new credit card account.”

With respect to Claim 8, Pitroda teaches “wherein the list of ineligible financial institutions comprises second the financial institution and any financial institutions associated with the second financial institution with which the second credit account is held.” (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see at least Walker Abstract and Summary, and C 2, ~L 20-30)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

Examiner notes that Walker explicitly teaches about balance transfer and states that “it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds

Art Unit: 3694

transfer, which draws the old account balance onto the new credit card account.”

With respect to Claim 9, Pitroda teaches “receiving from the account holder an indication that the account holder is interested in transferring a balance to the second credit account;” (see atleast Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

“wherein obtaining account data is performed in response to receiving said indication.” (see atleast Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see atleast Walker Abstract and Summary, and C 2, ~L 20-30)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

Examiner notes that Walker explicitly teaches about balance transfer and states that “it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer, which draws the old account balance onto the new credit card account.”

With respect to Claim 10, Pitroda teaches “further comprising displaying at least a portion of said account data to the account holder.” (see atleast Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

With respect to Claim 11, Pitroda teaches “further comprising displaying at least a portion of said account data to the account holder in the event it is determined that the first financial institution is not the same as or affiliated with the financial institution.” (see atleast Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

With respect to Claim 12, Pitroda teaches “providing to the account holder a balance transfer request display, the display comprising a data entry field;” (see atleast Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

“populating the data entry field with at least one element of said account data.” (see atleast

Art Unit: 3694

Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C17, ~L 37)

With respect to Claim 13, Pitroda teaches “providing to the account holder a balance transfer request display, the display comprising a data entry field;” (see atleast Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

“in the event it is determined that the first financial institution is not the same as or affiliated with the second financial institution, populating the data entry field with at least one element of said account data.” (see atleast Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see atleast Walker Abstract and Summary, and C 2, ~L 20-30)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

Examiner notes that Walker explicitly teaches about balance transfer and states that “it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer, which draws the old account balance onto the new credit card account.”

With respect to Claim 14, Pitroda teaches “A system for online transfer of a balance comprising: a computer system configured to:” (see atleast Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

“receive an online balance transfer request for transferring a balance from a first credit account associated with an account holder to a second credit account associated with the account holder;” (see atleast Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

“obtain account data associated with the first credit account, said account data comprising at least the financial institution with which the first credit account is held;” (see atleast Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

“determine whether the balance request meets at least one eligibility requirement, the at least one

Art Unit: 3694

eligibility requirement comprising a requirement that a first financial institution with which the first credit account is held is not related to a second financial institution with which the second credit account is held;" (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

"process the online balance transfer request if all eligibility requirements are met and, otherwise, not processing the received balance transfer request;" (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

"a network connection associated with the computer system and configured to enable the computer system to receive data transmissions from and send data transmissions to the account holder." (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see at least Walker Abstract and Summary, and C 2, ~L 20-30)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

Examiner notes that Walker explicitly teaches about balance transfer and states that "it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer, which draws the old account balance onto the new credit card account."

With respect to Claim 15, Pitroda teaches "wherein said computer system comprises two or more computers." (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

With respect to Claim 16, Pitroda teaches "A computer program product for online transfer of a balance from a first credit account associated with an account holder to a second credit account associated with the account holder, the computer program product being embodied in a computer readable medium and comprising computer instructions for:" (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

"obtaining account data associated with the first credit account, said account data comprising at

Art Unit: 3694

least the financial institution with which the first credit account is held;” (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

“determining whether the balance request meets at least one eligibility requirement, the at least one eligibility requirement comprising a requirement that a first financial institution with which the first credit account is held is not related to a second financial institution with which the second credit account is held;” (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

“process the online balance transfer request if all eligibility requirements are met and, otherwise, not process the online balance transfer request.” (see at least Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see at least Walker Abstract and Summary, and C 2, ~L 20-30)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

Examiner notes that Walker explicitly teaches about balance transfer and states that “it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer, which draws the old account balance onto the new credit card account.”

Response to Arguments

7. Applicant's Remarks and Arguments dated November 21st, 2008 with respect to the rejection of amended Claims 1-16 have been carefully considered, but they are not persuasive. Additionally, Examiner notes that with the Applicant's Amendments to the Claims, Examiner respectfully disagrees with the arguments submitted by the Applicant and the rejection of amended Claims 1-16 under 35 USC 103(a) and 35 USC 112 is being maintained with some

modifications in this Office Action, where needed, to provide clarification. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

As noted above in respective sections, Examiner has Withdrawn a majority of the 35 USC 112, second paragraph rejections as noted in the individual items based on the amendments and/or clarifications submitted by the Applicant on 21st November, 2008. Additional language has been added to provide clarification in 35 USC 112, second paragraph rejections, and some language changes have been suggested to overcome 35 USC 112, second paragraph rejections.

Examiner respectfully suggests that the Applicant may consider revising the currently recited claims language. Examiner notes that the Court of Appeals for the Federal Circuit (CAFC) has noted that claims were held indefinite in such circumstances. If the language of a claim, considered as a whole in light of the specification and given its broadest reasonable interpretation, is such that a person of ordinary skill in the relevant art would read it with more than one reasonable interpretation, then a rejection of the claim under 35 USC 112, second paragraph is appropriate. (see MPEP 2173.05 (a), also see MPEP 2143.03 subsection I and MPEP 2173.06) Where the claim is subject to more than one interpretation and at least one interpretation would render the claim indefinite over the prior art, examiner should reject the claim as indefinite under 35 USC 112, second paragraph and should reject the claim over prior art based on interpretation of the claim that renders the prior art applicable. (see MPEP 2173.05 (a), also see MPEP 2143.03 subsection I and MPEP 2173.06)

In response to applicant's argument that the claims are interpreted in light of the Specification using certain terms, Examiner respectfully clarifies that limitations from the

Specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). (emphasis added)

Examiner notes that in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, the Applicant is informed that the references cited in the rejection of claims must be read in entirety as other passages and drawings may also apply.

In response to Applicant's amendments to independent Claims and arguments against the 35 USC 103 rejection, Examiner notes that when combining references for rejection under 35 USC 103, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to the Applicant's arguments against the Pitroda reference that it only teaches about the Universal Electronic Transaction (UET) Card, Examiner notes that Pitroda also teaches about system and methods of conducting electronic transactions as reflected in its title and as shown from the following paragraphs about transferring account information (in its Summary)---
"This invention also includes a method of transferring account information and accumulated transactional information for a plurality of credit transactions for a service institution

account from a UET card to a personal computer. The method comprises the steps of establishing an electronic communication between a personal computer and a UET card; selecting at least one service institution account; selecting from the at least one service institution account credit transactions for such account which were transacted in a predetermined period of time; and, transmitting from the universal electronic transaction card the selected credit transactions to storage means in a personal computer. The selected credit transactions may thereafter be displayed on the personal computer in the form of a monthly statement of the type normally provided on paper by the service institution."

and another paragraph in Pitroda's Summary ---

"There are several advantages to the present invention. With respect to credit card transactions, the UET card of the present invention may be used to store in memory each credit card or bank transaction for which it is used. Those transactions may be displayed on the display of the UET card. Alternatively, the contents of memory may be electronically transferred to a personal computer for use in any one of a number of commercially available personal accounting programs, such as the program commercially sold under the name "QUICKEN". Alternatively, the information could be used with spreadsheet programs, such as

LOTUS or EXCEL. Alternatively, the UET card may be provided with a disk containing a program that may be used on a personal computer to display and print the information. Or, for those card users who might not own a personal computer, a printer may be provided to interface with the card and to print the record of the desired transaction or transactions."

Additionally, examiner notes that Walker teaches about transfer of balance/debt as in ---
"Credit cards today have become a pervasive method of payment for goods and services. They not only offer convenience, security, and flexibility in the commercial transaction process, but also provide some limited flexibility in the assignment of debt obligation. For example, it is well known in the art that credit card holders are free to **transfer** debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such **transfers** are typically done by paying off the old account with a convenience check or electronic funds **transfer**, which draws the old account **balance** onto the new credit card account."

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to the Applicant's disclosure and review for not traversing already issued patents by the claims of the current invention of the Applicant:

- US Patent No. 5,857,079 issued to Claus et al. filed on December 23, 1994 and titled: "Smart Card for Automatic Financial Records".
- US Patent No. 6,044,360 issued to Picciallo, Michael J. filed on June 16, 1997 that is claiming priority from April 16, 1996 and titled: "Third Party Credit Card".

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjeev Malhotra whose telephone number is 571-272-7292. The examiner can normally be reached on Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

11. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, these are minimum citations and other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully

Art Unit: 3694

consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

/SM/

18 December, 2008

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694